

REMARKS

Claims 1 – 15 are pending. Claims 1 – 4, 7, 8, 10, 11, 13 and 14 have been allowed. The applicants respectfully request reconsideration and allowance of this application in view of the above amendments and the following remarks.

Claims 12 and 15 were rejected under 35 USC 112, first paragraph, as being indefinite. Although the basis for the rejection is respectfully questioned in the comments below, claim 12 has been amended. Claims 12 and 15 are rejected due primarily to an alleged lack of support in the specification.

The Amendment that added claim 12 states that “support for claims 10 – 15 is located in, for example, page 11, lines 4 – 17.” (Amendment, page 11.) The examiner is obligated to explain why this particular description fails to provide a description of the invention defined by the claims. MPEP § 2163.04 (“If applicant amends the claims and points out where and/or how the originally filed disclosure supports the amendment(s), and the examiner finds that the disclosure does not reasonably convey that the inventor had possession of the subject matter of the amendment at the time of the filing of the application, the examiner has the initial burden of presenting evidence or reasoning to explain why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims”). However, the final Office action simply states that ““data is transmitted responsive to receipt thereof” was not taught in specification and drawing,” and does not present evidence or reasoning as to why one would not recognize in the disclosure a description of the recited invention.

More particularly, in rejecting a claim under 35 USC 112, first paragraph, the examiner must set forth express findings of fact regarding the above analysis which support the lack of written description conclusion. These findings should:

(A) Identify the claim limitation at issue; and

(B) Establish a *prima facie* case by providing reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed. MPEP § 2163.

Here, the examiner has provided only finding (A), but not (B). There is no showing why the discussion on page 11, lines 4 - 17 including, for example, that “It [the transmitter circuit 18] processes the data (RF data indicating lock or unlock of door) from the microcomputer 12 with the signal processing circuit as the transmitting data and transmits this transmitting data from the antenna to the door lock device D using a radio signal” fails to show that the inventor was in possession of the invention of claim 12 “the data is transmitted responsive to receipt thereof,” where claim 12 depends from claim 9 reciting “further comprising transmitting data as a radio signal from the signal transmitter.”

Without acknowledging the propriety of the rejection, applicants have amended the claims to improve the clarity thereof. Accordingly claim 12 has been amended as to matters of form only to address the Examiner’s concerns relating to the wording and not for reasons related to patentability. Thus the scope of claims 12 and 15 has not been narrowed within the meaning defined in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722 (2002).

Claims 5 and 6 were rejected under 35 USC 102(b) as being anticipated by U.S. Patent No. 4,652,108, Iida et al. (“Iida”). The applicants respectfully request that this rejection be withdrawn for the following reasons.

The arguments previously presented are hereby incorporated by reference.

Iida does not teach every element recited in claims 5 and 6. For a *prima facie* case of anticipation, “the identical invention must be shown in as complete detail as is contained in the ...

claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Examples are provided below of elements which Iida fails to teach or suggest.

The office action cites Iida, Fig. 1, element 2 as teaching "generating a switching pulse" as recited. To the contrary, Iida, Fig. 1, element 2 is just a power switch and does not perform "generating a switching pulse at a second fixed frequency higher than the first fixed frequency," as further recited. Iida fails to teach or suggest that switch 2 is used for generating a switching pulse at a second fixed frequency, e.g., by being repeatedly turned on and off.

Also, Iida fails to teach "generating a switching pulse at a second fixed frequency ... during the ON-period of the voltage boosting control signal."

Moreover, Iida is directed to a "driving device for illuminating lamp of flash apparatus," and is quite different from a "method of operating a signal transmitter" in claims 5 and 6.

With respect to claim 5, the final Office Action states that "Iida teaches a driving device in response to a variation of power source voltage. The driving device, more specific, an electronic flash apparatus (shown in Fig. 1) constitute as a transmitter device. Therefore, Iida meet the claim limitation." Applicants previously traversed the factual assertion that transmitting data as a radio signal as light is "inherent" and requested a citation to a reference or an Examiner's affidavit. 37 CFR 1.104(d)(2). Stating that "an electronic flash apparatus ... constitute as a transmitter device" does not avoid the statutory requirement that "the examiner must provide documentary evidence in the next office action if the rejection is to be maintained." MPEP 2144.04(C). In addition, the failure to provide the required documentary evidence to support the statement acquiesces to the applicants' traversal of the statement. The Examiner accordingly cannot maintain the rejection of claim 5 because she failed to provide the required

documentary evidence. MPEP 2144.04(C). Accordingly, (1) the finality of the office action is in error, and (2) claim 5 must be allowed.

Moreover, the Office Action fails to show that Iida teaches each and every claim limitation. The Office Action argues that Iida teaches “a signal transmitter circuit” because “the electronic flash apparatus (shown in Fig. 1) constitutes a transmitter device.” Even if this is an accurate statement, which applicants vigorously deny, “an electronic flash apparatus” fails to teach or suggest the recited “signal transmitter.”

Further, according to Iida, Fig. 1 in its entirety “is a block diagram of an electronic flash apparatus.” Clearly, the citation in the office action of all of Fig. 1 to meet a recited element of claim 5 (the signal transmitter circuit), and then the citation of portions of Fig. 1 to meet other recited elements (such as the battery in Fig. 1) is further evidence that Iida fails to anticipate the invention as recited in claims 5 and 6.

Iida fails to teach or suggest, for example, these elements recited in claims 5 and 6. It is respectfully submitted therefore that claims 5 and 6 are patentable over Iida. In addition, Iida clearly fails to show other recited elements as well.

Claim 9 was rejected under 35 USC 103(a) as being unpatentable over Iida. It is respectfully requested that the rejection of claim 9 be reconsidered and withdrawn for reasons including the following, which are provided by way of example.

Claim 9 is considered to be patentable for reasons including its dependency from claim 5.

Also, with respect to claim 9, the final Office Action states that “The type of signal transmitted is inconsequential for the invention as a whole and present no new or unexpected results, so long as the signal has been transmitted successfully. Therefore, to have a radio signal in Iida et al. would have been matter of obvious design choice.” To the contrary, even if a mere

“obvious design choice” is alleged, “the prior art must provide a reason for a worker in the art, without benefit of appellant’s specification, to make the necessary changes in the reference device.” *E.g., In re Chicago Rawhide Mfg. Co.*, 223 USPQ 251 (BPAI 1984).

The examiner previously made the same argument with respect to claims 5 and 6, although the examiner has restated her previous inherency argument as an “obvious design choice” argument with respect to claim 9. Applicant previously traversed the factual assertion that transmitting data as a radio signal as light is “inherent” and requested a citation to a reference or an Examiner’s affidavit. 37 CFR 1.104(d)(2). Changing a factual assertion from “inherency” to “obvious design choice” does not avoid the statutory requirement that “the examiner must provide documentary evidence in the next office action.” MPEP 2144.04(C). In addition, the failure to provide the required documentary evidence to support the statement acquiesces to applicants’ traversal of the statement. The Examiner accordingly cannot maintain the rejection of claim 9 because she failed to provide the required documentary evidence. MPEP 2144.04(C). Accordingly, (1) the finality of the office action is in error, and (2) claim 9 must be allowed.

For at least these reasons, the combination of features recited in claim 9, when interpreted as a whole, is submitted to patentably distinguish over the prior art. In addition, Iida clearly fails to show other recited elements as well.

In view of the foregoing, the applicants respectfully submit that this application is in condition for allowance. A timely notice to that effect is respectfully requested. If questions relating to patentability remain, the examiner is invited to contact the undersigned by telephone.

Please charge any unforeseen fees that may be due to Deposit Account No. 50-1147.

Respectfully submitted,



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